IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Examiner: PHAM, MICHAEL
TRAN	Art Unit: 2811
Application No.: 10/779,537	
Filed: 2/14/2004	**REPLY TO EXAMINER'S ANSWER**

Applicants submits the Reply in response to the Examiner's Answer.

THE SECTION 102 REJECTION

Claims 1, 4-7, 11-12, and 16-17 were rejected as anticipated by Grune. A Section 102 rejection requires each and every element to be present. Here, Grune fails to show a number of elements.

First, Grune fails to show searching remote databases for relevant patents. The Answer relied on Grune's 0027 as showing the remote databases. However, Grune's 0027-29 simply shows that "the user utilizes a client computer to access the server. The client computer accesses a server computer, and both are connected on a global area network. The server system accesses the databases containing intellectual property and non-intellectual property scientific information upon receiving appropriate operator commands. The databases are mined for appropriate information that is of interest to the user. The mined information is then returned through the server to the client computer for the user's access." **Since all the databases are stored in the server system, Grune shows local databases rather than remote databases.** In contrast, the claimed searching one or more remote databases (examples are shown in Figs. 7 and 10-13 of the application and discussed on pages 16 and 20), the system searches remote databases such as the PTO's web site, the EPO web site, or the JPO web site, for example, and locate relevant patent information for the user.

Second, Grune fails to show the network analysis element. Pages 17-18 of the Examiner Answer noted that "Grune, [48] that the program can be used to map patent citations or patent claims in hyperbolic tree formats] and displaying one or more patents

(intellectual property) [Grune [048] The program allows for simultaneous modeling of the valuation and intellectual property results. The results may be displayed in various graphical formats.] is suggested."

Grune's paragraph 48 relates to the display of a particular graphical format known as hyperbolic tree. Specifically, Grune discloses that

> The program allows for simultaneous modeling of the valuation and intellectual property results. The results may be displayed in various graphical formats. Hyperbolic trees allow for the display of information on a hyperbolic plane using a focus plus context technique. The center of the tree is called a root, and the branches of information related to the root are displayed in the hyperbolic plane. The focus is easily shifted to a different part of the hyperbolic tree using a pointer device, such as a mouse, to choose a different root center.

Grune's paragraph thus relates to the display of the result. Grune's paragraph 048 corresponds to the display operation recited in claim 1 and, as discussed on page 18 of the instant application, Figs. 8-9 show exemplary mappings of IPs that are analogous to Grune' paragraph 0048. As mentioned therein, in the exemplary display of Fig. 8, each patent is represented as a sphere. In Fig. 9, the patents are arranged as hyperbolic trees.

The Answer relied on Grune's paragraph 3 for the proposition that mapping is network analysis and further asserted on page 18 that "Appellant offers no real argument that mapping is not a network analysis." Applicant disagrees. Grune's 003 discloses the background information that "Aurigin's and Delphion's tools allow for the search and analysis of patent information by mapping or clustering. This allows a user to understand how a group of patents or claims are related." This background information is used to set the stage for Grune and thus does not teach or suggest the network analysis. **Although Grune's paragraph 0048 discusses the modeling of the valuation and intellectual property results and displaying patent citations or a patent's claims in hyperbolic tree format, Grune's valuation modeling and display fails to show the claimed network analysis, which involves the application of network theory or graph theory.**

As Grune fails to disclose each and every element of the claim, Grune cannot anticipicate claims 1 and 16 and claims that depend therefrom such as claims 4-7, 11-12 and 17. Withdrawal of the Section 102 rejection is requested.

Further, Grune fails to disclose the additional citations of the dependent claims. For example, Grune's paragraph 11 fails to anticipate claim 4 since Grune's "Knowledge

management utility enables users to find solutions to problems by semantically analyzing documents by breaking sentences into noun-verb-adjective trees and then applying such tools as synonym indexes." Grune's 0033 notes that "Users can submit a document in a query form and ask ActiveKnowledge to find other documents on similar topics in databases and on the Internet. Autonomy's technology analyzes the frequency of character strings in documents that it finds to determine which strings address the same topics as the submitted document." However, the analyses of frequency of character strings are not the same as clusterizing patents according to word similarity. **The Answer admitted this missing link by concluding that clustering patents according to word similarity could further be suggested in this context (page 19 of Answer at last sentence of third paragraph). "Could" is not a proper basis for a rejection.**

Grune'paragraph 60 fails to anticipate claim 5 since Grune's split screen/full screen format is not the same as plotting on the claimed large format plotter. There is no plotter mentioned in Grune. The Office Action is improperly using hindsight from the instant application to support the rejection.

As to claim 6, Grune's paragraph 10's audio/visual means in no way discloses or teaches the specifics of three-dimensionally visualizing the patents on a 3D display device. The Answer cited para. 45 which states "Visual mapping of information in 2-D and 3-D format is demonstrated at www.antarcti.ca." Howerver, antarti.ca simply shows 3D format on a 2D display device. Hence, nothing in Grune shows displaying the data in a 3D display device. The use of a 3D display device such as a holographic display allows easy manipulation of data. **The showing of 3D pictures in a 2D display device is commonly done, but that is not what the claim recites, namely a 3D display device.**

As to claim 11, Grune's Fig. 5 shows an Internet connected computer, but fails to show that the search work being distributed over a plurality of client computer (peer-to-peer (P2P) distribution of search load over a number of client computers). The Grune sections that the Examiner relied on shows that a client searches a server computer. **However, nowhere in Gruner does it show that a plurality of clients operate in tandem to satisfy the search request as part of a collective group of clients that answers the search.** The Grune server computer is not a plurality of client computers. Thus, by his own admission, Grune cannot anticipate claim 11.

As to claim 12, Grune fails to show the P2P distribution of search load, further where the client computer is behind a firewall. The Examiner relied on paras 13 and 15. However, **nowhere in Gruner does it show a client sitting behind the firewall to perform the distributed search operation as part of a collective group of clients that answers the search.**

As to claim 16, Grune fails to anticipate this claim since **it does not show the means for performing network analysis in paragraph 48** as discussed in detail above.

As to claim 17, Grune's paragraph 48 fails to show the means for generating a computer readable intellectual property mapping file, as discussed above. Further **Grune's paragraph 14 fails to disclose the generating means such as computer code for generating a collection of patent documents, each having one or more links embedded in the first portion referencing one or more external documents viewable using a viewer application; and one or more links embedded in the third portion referencing information contained in the second portion; and links generated by a network analysis of relationships among the patent documents as further shown on claim 18.**

Since Grune fails to disclose elements recited in the dependent claims as well as the dependent claims, Grune cannot anticipate any of the claims. Withdrawal of the rejection is respectfully requested.

THE SECTION 103 REJECTION

Claims 2, 14-15 and 18-20 were rejected under Section 103 as unpatentable over Grune in view of Yeh. Yeh shows a system for displaying patent analysis information includes a patent information table, a citation analyzing module, an XML (extensible markup language) converting module, an image converting module, and a user processing module.

With respect to claim 2, Grune does not show the searching of remote databases as well as the network analysis. **Grune and Yeh do not show the network analysis and fails to show the specifics recited in claim 2 of receiving as a query one or more keywords or assignees to be searched; searching the query in Issued Patent or Published Application databases; retrieving cited prior art patents for each patent**

found in search results; updating the query by adding assignees from the cited prior art patents; and running a second search using the updated query. The rejection fails to address each element of claim 2, and thus fails to show that claim 2 is unpatentable over Grune and Yeh. T**he Answer repeatedly relied on "is suggested" on pages 25, but provides no specific citations of the presence of the claimed language of claim 14.** Since a Section 103 rejection requires the prese

As to independent claim 14, Grune and Yeh fail to disclose the specific combination of: (a) receiving as a query one or more keywords or assignees to be searched; (b) searching the query in Issued Patent or Published Application databases; (c) retrieving cited prior art for each patent found as search results; (d) updating the query by adding assignees from the cited prior art; (e) iteratively repeating (b)-(d) using the updated query.

The Office Action acknowledged that "Grune does not explicitly disclose (c) retrieving cited prior art for each patent found as search results and relied on Yeh at 0038 which shows that a citation analysis module is used to generate citation information of a designated patent according to patent summary information stored in the patent information table." However, **Yeh shows only citation information and does not show that cited patents are retrieved**. Thus, the Office Action takes liberty with what Yeh shows and impermissibly uses hindsight from the present invention to arrive at its conclusion. T**he Answer repeatedly relied on "is suggested" on pages 26-27, but provides no specific citations of the presence of the claimed language of claim 14.**

Applicant has carefully reviewed Grune and Yeh and fails to see how paragraphs 11, 14 and 48 show that the computer automatically performs updating the query by adding assignees from the cited prior art and iteratively repeating (b)-(d) using the updated query. Such iterative searches are used to improve the accuracy of the search result. As a number of elements in the combination are completely missing in Grune and Yeh, they cannot render the claims obvious.

As to claim 15, as discussed earlier, Grune does not show the network analyzing the search results. Grune simply mentions that the server performs the search results. **Grune does not show the client computer performing the network analysis** as part of the search solution.

As to claim 18, the examiner improperly used hindsight to reconstruct the invention. **Nowhere in Yeh does it show the claimed specifics of a collection of patent documents, each having one or more links embedded in the first portion referencing one or more external documents viewable using a viewer application; and one or more links embedded in the third portion referencing information contained in the second portion; and links generated by a network analysis of relationships among the patent documents**. This is the case since the claim relates to a patent document (in one instance a PDF document) with three portions. In one embodiment, the PDF patent document contains a prior art citation in the first section with links to the prior art, a description portion and a claim portion, where the claims contain links to references to the claim language in the description portion. The Office Action misconstrued claim 18, and then goes on a fanciful reconstruction on that incorrect construction of the claim. Yeh clearly does not disclose the element recited in claim 18.

As to claim 19, as discusssed above for claim 14, Grune and Yeh fail to show the elements recited in claim 14 and 19. As to claim 20, Grune's Fig. 5 merely shows conventional client and server architecture and does not show claim 20's distributed processing such as the peer-to-peer distributed processing, for example. In sum, many of the specifics cited in the dependent claims are not shown. Hence, withdrawal of the Section 103 rejection is requested.

Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Grune and further in view of Munzer. Again, as discussed above, neither Grune nor Munzer shows the network analysis element in the independent claims. Further, Munzer fails to show creating spring relationship among patents based on number of citation of patent prior art; and generating a spring mass diagram. There is no suggestion of the specifics of using citation as the basis for creating the spring relationship. Such suggestion came from the teachings of the present invention, and the Office Action has improperly applied hindsight in combining Grune and Munzer to arrive at claim 3. Withdrawal of the Section 103 rejection on claim3 is requested.

The Office Action rejected claims 8-10 and 13 over Grune and Rivette. The Office Action asserted that Rivette discloses a caching sub-system that caches/retrieves cached patent data and asserts that such caching is the same as the claimed caching

results from prior IP maps in a remote computer. **Rivette shows an enterprise server with a local cache rather than remote client computers that performs caching of the IP data in a peer-to-peer context**. Hence, Grune and Rivette fail to show the claimed invention.

First, claims 8-10 and 13 are patentable over Grune and Rivette as they depend from allowable claim 1. As to claim 8, Grune and Rivette fail to show caching at a remote client computer. As to claim 9, Grune and Rivette fail to show retrieving a cached IP map from the remote client computer in response to a user request. Further, as to claim 10, Grune and Rivette fails to mention cache flushing at all. As to claim 13, Grune and Rivette fail to show the combination of annotating a patent at a local computer and caching the annotated patent at a remote computer to satisfy a subsequent request for the patent. Withdrawal of the Section 103 rejection is requested.

CONCLUSION

In view of the above, Applicant respectfully submits that all claims are in condition for allowance.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,

By: _____

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